

APPENDIX A
Copy Of The January 18, 2001 Restriction Requirement
Imposed In U.S. Patent Application Serial No. 09/328,116

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B.S.T.&Z.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/327,116 06/07/99 ESLAMY

003401.P093

EXAMINER

MMC2/0118

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RECEIVED
JAN 29 2001

DEPT. A	ART UNIT	PAPER NUMBER
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2858
DATE MAILED:

01/18/01

BLAKELY, SOKOLOFF, TAYLOR & ZARMAN
LOS ANGELES

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

FormFactor, Inc.
IP Department

Date: 2/12/01 By: [Signature]
Action: Post-Response
Due Date: 2/18/01
In: 2/18/01
Final: 2/18/01
File No: P93-115
Attorney/Firm: JAT/LAB

Date	2/18/2001	Client Name	FormFactor, Inc.
Pocket Initial	10	3401-P093	
Doc. Sup. Initial	[Signature]		
Atty/Initial	JCS JAT		
Pat/Ser/Reg	327,116	Description	
Response due			

ENTERED

JAN 29 2001

STATUS DB-LA

[Signature]

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Office Action Summary	Application No.	Applicant(s)	
	08/327,116	ESLAMY ET AL.	
	Examiner	Art Unit	
	Anjan K Deb	2868	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 07 June 1999.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-86 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 1-86 are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892).

16) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

18) ☐ Interview Summary (PTO-413) Paper No(s) _____.

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: _____.

U.S. Patent and Trademark Office
PTO-326 (Rev. 9-00)

Office Action Summary

Part of Paper No. 5

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SEGMENTED CONTACTOR

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-42, drawn to method of making segmented contactor, classified in class 29, subclass 593.
 - II. Claims 54-57, drawn to method of making segmented contactor comprising separating a tile from a substrate, classified in class 29, subclass 593.
 - III. Claims 43-53, drawn to method of assembling segmented contactor, classified in class 29, subclass 876.
 - IV. Claim 58, drawn to method of repairing segmented contactor, classified in class 29, subclass 402.01.
 - V. Claims 59-86, drawn to method of electrical testing segmented contactor, classified in class 324, subclass 765.

Distinctness

2. The inventions are distinct, each from the other because:

Inventions (I) and (II) are distinct because Invention (I) does not require the step of separating a tile from a substrate.

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Inventions (I) and (III) are distinct because Invention (I) does not require the step of providing an assembly fixture.

Inventions (I) and (IV) are distinct because Invention (I) does not require the step of removing a selected mounted contactor.

Inventions (I) and (V) are distinct because Invention (I) does not require the step of connecting plurality of electrically conductive leads to an external testing instrument.

Inventions (II) and (III) are distinct because Invention (II) does not require the step of providing an assembly fixture.

Inventions (II) and (IV) are distinct because Invention (II) does not require the step of removing a selected mounted contactor.

Inventions (II) and (V) are distinct because Invention (II) does not require the step of connecting plurality of electrically conductive leads to an external testing instrument.

Inventions (III) and (IV) are distinct because Invention (III) does not require the step of removing a selected mounted contactor.

Inventions (III) and (V) are distinct because Invention (III) does not require the step of connecting plurality of electrically conductive leads to an external testing instrument.

Inventions (IV) and (V) are distinct because Invention (IV) does not require the step of connecting plurality of electrically conductive leads to an external testing instrument.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Election of Species

3. If applicants elects Invention (I) a further election of species is required.

This application contains claims directed to the following patentably distinct species of the claimed invention:

- A. Species to which claims 1-10 is drawn to.
- B. Species to which claims 11-25 is drawn to.
- C. Species to which claims 26-42 is drawn to.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, it appears that no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

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limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Election by Telephone

4. A telephone call was made to attorney of record, Mr. Joseph A. Twarowski, on 1-16-01 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Anjan K. Deb whose telephone number is (703) 308-2941. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Safet Metjahic can be reached at (703)- 308-1436.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone numbers are (703)-308-0956 and (703)-305-4900.

AD

1/16/01


VINH P. NGUYEN
PRIMARY EXAMINER
GROUP 2858
01/16/2001